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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/577.927 05/24/00 WELLE

R 7413-1004

021131  
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MMC1/0425

EXAMINER

HANIG, R  
ART UNIT PAPER NUMBER

2873  
DATE MAILED:

04/25/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/577,927

Applicant(s)

WELLE, RICHARD P.

Examiner

Richard Hanig

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-24 is/are allowed.
- 6) ☒ Claim(s) 25-39 is/are rejected.
- 7) ☒ Claim(s) 26 and 37 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9-12-00.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The amendment filed 2/12/01 proposes amendments to claim 25 that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required. Claim 25 has to be presented with corrections either underlined or bracketed.

2. Claims 25-39 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. V. Stein, Inc.*, 142 F. 3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F. 3d 1464, 45 USPQ2D 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F. 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by filing of the present reissue application. Specifically, applicant can not acquire claims that are broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects. The reissue claims' scope are narrower with respect to applicant's patent claims of a taggant method such as the use of a pen or in clothing, but broader with respect to using isotopic taggant or defining the specifics of the isotopic ratios that were argued in the rejection of the initial claims in the parent application. With respect to

Art Unit: 2873

applicant's arguments, The claims were amended to include "wherein said abundance ratio being unchanged by chemical reactions and on page 14 of the remarks section of amendment of 1/26/98 of application 08/668,648 the applicant argued that the references did not show the above quoted phrase. Also claims drawn to the use of taggants without the inclusion of isotopes is broader over the examiners reasons given for allowance which the applicant has agreed to by not submitting any response to the examiners reasons for allowance.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 25, 27-36, 38, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soberman et al (4,363,965) in view of Winnik et al (5271764) and Goldblatt et al (3788814). Soberman et al in col. 3, line 43 discuss using non-radioactive isotopes as taggants as identifiers in various compounds. In col. 7, line 45 they discuss using various isotopically enriched forms of the taggants. The reference does not disclose using the taggants in any type of marking procedure but Winnik et al describe the use taggants in ink jet ink for marking and encoding (see col.1, lines 6-10. It would have been obvious to one of ordinary skill in the art to put taggants and isotopic taggants in any type of marking system such as pens, paints, documents or clothing because as Winnik et al teach it can be done with ink jet ink and therefore any equivalent marking system. Soberman et al do not discuss various coding methods, the details of measuring the isotopic ratios or the correction for contaminants. The coding method is an obvious step one would make to associate and identify a taggant with a substance. Goldblatt et al (col.2) discuss

Art Unit: 2873

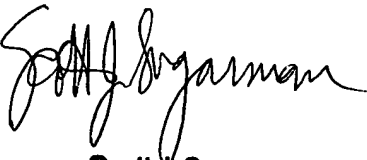
the measuring of isotopic ratios and shows that it is well known, and the method used to extract the relevant information would also have a procedure for accounting for contaminants because this is a standard problem that is handled in analytical chemistry. It would have been obvious to one skilled in the art to use Goldblatt et al in Soberman et al and Winnik et al because these are the standard techniques that are used to get isotopic ratios and make corrections for contaminants which give accuracy to the method.

5. Claims 26, 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The specific coding system of these claims are not shown or suggested in the prior art. . For claims 1-24 see paper no. 2.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Hanig whose telephone number is 703-308-4853. The examiner can normally be reached on M-F: 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 703-308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7721 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

AA  
April 20, 2001

  
Scott J. Sugarman  
Primary Examiner